

III. REMARKS

Status of the Claims

Claim 3 is amended. New claims 21-23 are added. Claims 1-23 are presented for further consideration.

Summary of the Office Action

Claims 1-9 and 12-20 stand rejected under 35USC103(a) on the basis of the cited reference Ronen, U.S. Patent No. 6,285,660 in view of the cite reference Lundin, U.S. Patent No. 6,198,933. Claims 10 and 11 stand rejected under 35USC103(a) based on the reference Ronen in view of Lundin and further in view of the cited reference Buswell European Patent No. 0936777, The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

Discussion of the Cited Reference

The Examiner relies on the reference Ronen as primary support for the rejection based on obviousness.

Ronen discloses a method for network management in which a user may influence the network parameters for a particular communication. According to the basic procedure of this reference, network information relating to current network conditions is provided to a user terminal. The user may select a specific combination of network parameters, and a request including the user selected network parameters is transmitted to a network control device. The network control device may allocate required network resources in accordance with the received request if the requirements in the request can be satisfied. If the request cannot be satisfied, the network control device may define alternative options and output these options to the user

device.

As a further missing feature, Ronen fails to disclose the currently claimed feature, namely, the checking of the reachability of a terminal (to which a connection is desired) in a local network. Ronen is limited to checking if the selected special service or the requested network parameters are supported by the network (col. 1, 1. 39-40, col. 2, 1. 17-20, and col. 8, 1. 8-9) and there is no indication with respect to further checking the reachability of the recipient device. Furthermore, Ronen does not disclose a mobile station capable of establishing a data transmission connection to a wireless local network and a public mobile network (as in current claims 12 and 18).

The Examiner seeks to combine the teaching of the cited reference Ronen with the teaching of Lundin. Lundin discloses a communication system providing position information transfer for roaming mobile stations. As illustrated in Figures 2 and 5, position requests may be transferred between public land mobile network (PLMN) mobile position centers (MPC) in different networks to obtain a current location of a roaming mobile station in a remote PLMN. This is not a service that is associated with a local area network but only involves location requests within a PLMN. Accordingly is not a teaching that is readily combinable with the teaching of Ronen. There is no need to process location requests within a LAN.

Additionally Lundin fails to teach 1) transmission of a service request for a data transmission service *from a mobile station to a PLMN, and* 2) transferring the request in response to a data transmission service not being providable via the local network. The teaching of Lundin is limited to a communication transaction

in which a location information request (originating from the service requestor) is forwarded from a first MPC to a second MPC when the mobile station is not located in a cell belonging to the same network as the first MPC (col. 6, 1. 58-60). The request may then be forwarded *between network elements*.

Further, as also missing from Ronen, Lundin does not teach the feature of checking the reachability of the terminal to which data transmission is desired from the mobile station in the local network, nor does Lundin teach the transmission of a service request from the mobile station to the public mobile network in response to the terminal not being reachable. Instead, Lundin teaches to only check the VLR address information col. 6, lines 53-55. Further, Lundin teaches to transmit a location information request on position of a roaming mobile station between network elements. The mobile station of Lundin is only capable of communicating with a PLMN.

Therefore, the combination of Ronen and Lundin fails to teach all aspects of the current combination of features of the current claims, including new claims 21-23, for a system comprising a wireless local network and a public mobile network. On the basis of the combination of the cited references it would not be obvious to trigger a connection establishment request to a public mobile network if the requested service cannot be provided and/or the terminal cannot be contacted in the local network, which may be completely independent from the public mobile network.

Further, the combination does not give any indication towards the features in the new claim 21, in particular towards a network element for a local network being configured to check the availability of a requested data transmission service and

reachability of a terminal (being accessed), or transmit a service request for evoking service request transmission from the mobile station to a public mobile network, in response to the data transmission service not being providable substantially in accordance with the service request and/or the terminal not being reachable via the local network.

The Issue of Obviousness

It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application.

Applicant submits that the above described deficiencies of the primary reference Ronen are not remedied by the proposed combination with the teaching of the reference Lundin. The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of Ronen or Lundin, in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art.

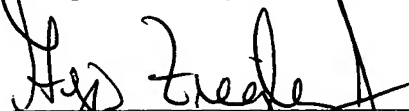
The above arguments apply equally to the rejected dependent claims.

The deficiencies of the combined teachings of Ronen and Lundin are not remedied by the Examiner's proposed further combination with the teaching of Buswell. Therefore, the rejection of claims 10 and 11 is not supported by the cited references.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check in the amount of \$800 is enclosed for a two-month extension of time and additional claim fees. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



Geza C. Ziegler, Jr.
Reg. No. 44,004

8 FEB 2004
Date

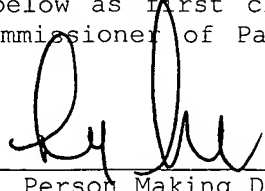
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